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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,221	08/27/2003	Kenichiro Uotani	03500.017508.	4314
5514 7590 10/16/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER GARCIA, GABRIEL I	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 10/16/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/648,221	<b>Applicant(s)</b> UOTANI, KENICHIRO	
	<b>Examiner</b> GABRIEL I. GARCIA	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8 and 10-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/27/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/1/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |



### **Part III DETAILED ACTION**

1. This application has been examined. Claims 1-2,4-8,10-12,14 and 15 are pending in this application. An attempt was made to contact the attorney of record on 10/10/08, however, Examiner was not able to reach him.

#### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “draws’ or “first drawing unit and/or second drawing unit” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-2, 4-8 and 10-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regard to claim 1, 7 and 13 and therefore its dependent claims, the limitations "draws or first drawing or second drawing" are not described in the specification.

4. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "said display control step" in lines 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,2,7,8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda et al. (2005/0281182) in view of Obara (2004/0141791).

With regard to claim 1, Honda et al. teaches an image processing method (fig. 6) which is used to confirm a layout when of an image which is to be formed onto a first recording medium on the basis of an application (reads on fig. 7 and 13, fig. 7 depicts the area where the label is printed, and fig. 13 depicts the system control that inherently holds the application or program to print the label [0066]), the first recording medium being of a disk shape and set in a printer (reads on figs. 6 and 7), said method comprising the steps of: forming the image based on said application (see figs. 6-15); and drawing an outer circumference of the first recording medium (reads on figs. 7 and 9; and drawing outer and inner boundaries, defining a label area therebetween inside the drawn outer circumference (figs. 7 and 11, depicts how the inner and outer boundaries are set, it is well within the skill of user to draw lines anywhere within the printed label for creating margins); and displaying the image so that a portion of the formed image corresponding to the label area and a portion of the image corresponding to an area which would overflow the label area can be discriminated, wherein the label area is suitable for printing on the first recording medium (reads on figs. 6-7, & 12, and [0042 & 0059], which depicts and describe how the images can be view and edit if the images are not within the desired location after viewing). Honda et al. does not teach using a dedicated tray of a printer. However, Obara (in the same field of endeavor "label printing") teaches that it is well known in the art to have a label printer having dedicated tray for a disk (see fig. 1). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to provide the printing device of Honda et al. with the dedicated tray of a printer as taught by Obara because of the following reasons: 1) it would allow the printing apparatus of Honda et al. to easily fit the disk into the tray for printing; and 2) it would allow the printing system of Honda et al. to held immovable the disk while data is being printed.

With regard to claim 2, Honda et al. further teaches discriminating step of discriminating, by a discriminating unit, whether a first mode of forming the image onto the first recording medium has been set (reads on the control to operate the printing of the label as described in [0008-0009]).

With regard to claims 7-8 and 13, the limitations of claims 7-8 and 13 are covered by the limitations of claims 1 and 2.  
value (**reads on figs. 1 and 2**).

### ***Conclusion***

6. Claims 4-8,10-12,14 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable (and if the 112 rejection is overcome) if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record does not teach or suggest the limitations (in combination with the features of the independent claim(s)) as recited in claims 4-8,10-12,13 and 14.

7. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriel I. Garcia whose telephone number is (571) 272-7434. The Examiner can normally be reached Monday-Thursday from 7:30 AM-6:00 PM. The fax phone number for this group is (571) 273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you



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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2600.

/Gabriel I Garcia/

Primary Examiner, Art Unit 2625

**Gabriel I. Garcia**  
**Primary Examiner**  
**October 11, 2008**